

REMARKS

By this amendment, claims 1-10 have been cancelled and claims 18-33 have been added. Thus, claims 11-33 are now active in the application. Reexamination and reconsideration of the application is respectfully requested.

In items 2-4 on pages 2 and 3 of the Office Action, claims 4-6, 9-14 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, II (U.S. 6,550,160) in view of either O'Brien (U.S. 3,218,734), Wellman (U.S. 4,875,683), or Chiroff (U.S. 4,407,079); and claims 7, 8, 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, II in view of O'Brien, Wellman or Chiroff and further in view of either Goldston (U.S. 5,588,227) or Cohen (U.S. 5,113,599).

These rejections are believed moot with respect to their application to claims 4-10 since claims 4-10 have now been cancelled. Furthermore, these rejections are respectfully traversed with respect to their application to claims 11-17, and it is respectfully submitted that these rejections are clearly inapplicable to all of the present claims 11-33, for the following reasons.

With exemplary reference to the present drawing figures, and as recognized by the Examiner, present claim 11 is directed to a pair of golf shoes including a right foot shoe and a left foot shoe, wherein an inflatable sealed bag 2 is provided only at the outside portion of the forward portion of the sole of only one of the right foot shoe and the left foot shoe, the inside portion of the forward portion of the sole of said one of the right foot shoe and the left foot shoe having no inflatable sealed bag thereat, and the other of the right foot shoe and the left foot shoe having no inflatable sealed bag. That is, of the right foot shoe and the left foot shoe, an inflatable sealed bag is provided only at the outside portion of the forward portion (i.e., the portion adapted to receive the little toe portion of the foot) of the sole of only one of the right foot shoe and the left foot shoe. No other portion of either shoe has an inflatable sealed bag provided at the sole. Also, the inflatable sealed bag has an air port 5 through which air can be injected to inflate the sealed bag. The sealed bag is thus arranged at the outside portion of the forward portion of the sole of said one of the right foot shoe and the left foot shoe so that, when a corresponding one of the right foot and the left foot is received in said one of

the right foot shoe and the left foot shoe and the sealed bag is inflated, the little toe portion of said one of the right foot and the left foot is raised relative to the big toe portion of said one of the right foot and the left foot.

New independent claim 18 is similar to claim 11, except that it is specifically directed to a pair of golf shoes for a right-handed golfer who swings a golf club from right to left during downswing. Thus, in this pair of golf shoes of claim 18, the inflatable sealed bag is provided only at the outside portion of the forward portion of the sole of the left foot shoe, no other portion of the sole of either shoe having an inflatable sealed bag thereat. New independent claim 25 is identical to new independent claim 18, except that it is directed to a pair of golf shoes for a left-handed golfer who swings a golf club from left to right during downswing. Thus, the pair of golf shoes according to claim 25 has an inflatable sealed bag provided only at the outside portion of the forward portion of the sole of the right foot shoe, with no inflatable sealed bag provided at the sole of any other portion of either of the right foot shoe and the left foot shoe.

With this arrangement of the present invention, the sealed bag 2 can be inflated prior to the golfer taking a swing, so that the little toe portion 15L of one of the golfer's feet (in particular, of the left foot for a right-handed golfer, or the right foot for a left-handed golfer) is raised relative to the big toe portion of the foot. This little toe portion 15L (for a right-handed golfer) serves as a bracing portion during a downswing and, with the sealed bag inflated, allows for proper bracing even for a golfer, for example a senior golfer, who has a somewhat weakened lower body. This bracing function allows for the golf swing to be correctly performed. For a detailed description of the problem recognized by the present inventor and solved by the present invention, please see paragraphs [0002]-[0010] on pages 1 -3 of the substitute specification filed June 20, 2002. Thus, it is apparent that each of the independent claims 11, 18 and 25 very specifically requires that an inflatable sealed bag is provided only at the outside portion of the forward portion of the sole of one of the right foot shoe and the left foot shoe of the pair of golf shoes.

In contrast, and contrary to the assertion of the Examiner that "Miller, II is silent as to the longitudinal location of the bag," (see second sentence of the body of the rejection in item 3 on page

2 of the November 20, 2003 Office Action), the Miller patent discloses a pair of golf shoes, wherein one of the shoes is provided with a bladder 22 specifically provided at least in the rear portion of the shoe. In this regard, the Examiner's attention is directed to Figs. 2-4 of the Miller patent which each show a longitudinal cross-section of the shoe having the bladder 22 (or 42), with the cross-section taken through the bladder 22, 42. In each of these drawing figures, it is apparent from an appraisal of the upper portion of each of these drawings figures that the cross-section is taken at a longitudinal portion of the shoe that includes the shoe opening through which the foot is inserted into the shoe, as illustrated in Fig. 1. As clearly seen from Fig. 1, the shoe-opening portion of the shoe is provided at the rear portion of the shoe, not at the front portion of the shoe. Accordingly, it is quite apparent that the bladder 22, 42 illustrated in Figs. 2-4 of the Miller patent is provided at least in the rear portion of the Miller shoe.

This also seems apparent from a review of the description of the Miller golf shoes contained in the Miller patent specification. Nowhere in the Miller description is there mention of a raising-up of the front outer portion of the sole portion of the shoe; rather, throughout the Miller specification, it is described that "one side of the foot is elevated to a height above the opposite side of the foot within the shoe" (see column 2, lines 11-14). Also see column 2, lines 14-17, "[b]y slanting the shoe from right to left, a right handed person is reminded to keep his/her weight on the left side of their foot when swinging a golf club, thereby making for a better swing." Also see column 3, lines 6-8, "[t]he bladder tilts the foot so that a right-handed person is forced to place their weight on the inside portion of their right foot." Furthermore, it can be seen from Figs. 2 and 3 that a cover plate 26 is provided above the bladder 22, and that as the bladder 22 is inflated, the cover plate 26 is tilted. This is described at, for example, column 3, lines 55-64 of the Miller patent. If the bladder 22 was provided only at a small portion of the length of the shoe, the plate 26 would not simply slant side-to-side, but would be inclined also front-to-back, which is not shown or described.

Therefore, for the above reasons, it is submitted to be apparent that the Miller bladder 22 extends longitudinally along the outside portion of the shoe, including at the rear portion of the shoe.

In the prior art rejection, the Examiner stated that “Miller, II is silent as to the longitudinal location of the bag. O’Brien, Wellman, or Chiroff teaches that the location for medial/lateral augmenting devices for golfing should be located in the forward portion of the shoe sole. It would have been obvious to locate the angling device in the forward portion as taught by either O’Brien, Wellman, or Chiroff in the pair of shoes of Miller, II to provide proper, secure angling of the foot for golfing.”

However, it is respectfully submitted that, contrary to the Examiner’s assertion, a person having ordinary skill in the art would not have been motivated to modify the Miller golf shoes to provide the bladder 22, 42 thereof in only the forward portion of the outside portion of the shoe sole, as required by claims 11, 18 and 25. That is, as described in the Miller patent, there are many devices in the prior art for helping to train a person to properly orient their body and their feet to provide an appropriate golfing stance, and different training aids are provided for different purposes and, in particular, “to help people perfect specific aspects of their swing.” (See column 1, lines 19-33 of the Miller patent). Miller, II specifically addresses his invention to the need that he saw that existed “for a device that can be used by a golfer when playing golf on the course that helps a golfer keep their weight on the inside of their foot as they golf.” (See column 1, lines 63-65). Miller addressed this problem specifically by providing a mechanism disposed “within the shoe for selectively slanting the one side of the shoe so that the one side of the foot is elevated to a height above the opposite side of the foot within the shoe.” (Underlining added). Thus, Miller specifically envisioned the need for slanting the golfer’s foot from right to left (for a right handed golfer) by providing the mechanism (bladder 22, 42) that elevates one side of the foot to a height above the opposite side of the foot within the shoe.

The Examiner has suggested modifying Miller, II in view of either O’Brien, Wellman or Chiroff to include the bladder at only the forward outer portion of the sole of the shoe, in view of teachings in these references of providing some removable apparatus to a shoe that elevates the front outer portion of the shoe. However, the purpose of the Miller, II patent is to elevate the entire outside portion of the golfer’s foot relative to the inside portion thereof. Obviously, if the Miller, II

invention was modified to provide the bladder 22, 42 only at the forward portion thereof for the purpose of meeting the present claims, then the purpose of Miller, II would be lost. For this reason, a person having ordinary skill in the art would not have been motivated to make this modification to Miller, II. See In Re Gordon, 733 F.2d 900, 902, 221, USPQ 1125, 1127 (Fed. Cir. 1984), (if, to meet the limitations of the claim, a device in a prior art patent would have to be modified in such a manner that “it would be rendered inoperable for its intended purpose, ...[then] [i]n effect, [that patent] teaches away from the... proposed modification”). It has long been held that a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. Bausch and Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Accordingly, it is submitted that a person having ordinary skill in the art would not have been motivated to modify the Miller, II invention to provide the bladder 22, 42 thereof only at the forward outside portion of one of the shoes thereof, in view of any of O’Brien, Wellman and Chiroff.

Furthermore, the Examiner cited the Goldston and Cohen references for teaching “placing hand pumps and valves on tongues of footwear.” However, these references provide no teaching or suggestion that would have obviated the above-discussed shortcomings of the Miller, II, O’Brien, Wellman and Chiroff references, as discussed above.

Therefore, it is respectfully submitted that claims 11, 18 and 25, as well as the claims depending therefrom, are clearly allowable over the prior art of record.

Next, in addition to the above reasons, independent claims 18 and 25 are further patentable over the applied references, for the following reasons.

As discussed above, claim 18 is specifically directed to a pair of golf shoes for a right-handed golfer who swings a golf club from right to left during downswing, and claim 25 is specifically directed to a pair of golf shoes for a left-handed golfer who swings a golf club from left to right during downswing. For the golf shoes provided for a right-handed golfer (claim 18), it is specified that the inflatable sealed bag is provided only at the outside portion of the forward portion of the sole of the left foot shoe. For the golf shoes provided for the left-handed golfer (claim 25) it is specified

that the inflatable sealed bag is provided only at the outside portion of the forward portion of the sole of the right foot shoe. Therefore, according to the present invention of claims 18 and 25, the inflatable sealed bag is provided only at the outside portion of the forward portion of the sole of the left foot shoe for a right-handed golfer and the right foot shoe for a left-handed golfer. As explained in detail in paragraph [0002]-[0010] on pages 1-3 of the substitute specification, this arrangement of the inflatable sealed bag of the present invention provides a golfer having a somewhat weakened lower body, such as a senior golfer, to have a proper bracing function during downswing, so as to allow for a proper golf swing.

In direct contrast to this invention of claims 18 and 25, the Miller, II patent provides the inflatable bladder 22, 42 in exactly the opposite shoe. In particular, Miller, II specifically teaches that the bladder 22, 42 is provided in the right shoe for a right-handed golfer, and in the left shoe for a left-handed golfer (see column 4, lines 50-56 of Miller, II, for example), exactly contrary to the present invention of claims 18 and 25.

Similarly, both the O'Brien and Wellman patents teach providing the removable support for the outside portion of the right foot of a right-handed golfer and the left foot of a left-handed golfer (see column 1, lines 67-70 of O'Brien; and see column 4, lines 6-18 and column 5, lines 29-33 of Wellman).

The Chiroff patent, on the other hand, discloses a golf aid device that attaches to the outside portion of the left shoe of a right-handed golfer and of the right shoe of a left-handed golfer. However, this device of Chiroff is distinctly different in structure, function and purpose than that of the Miller, II device, as well as from the present invention. In particular, the Chiroff device comprises a roll bar 19 having an arcuate pivoting surface 20 along the outside edge of the shoe. The function of the roll bar 19 is to allow the outside edge of the right-handed golfer's left foot to pivot following an impact with the ball and during the subsequent follow-through of the golfer's swing, and to preclude the golfer from remaining generally flat-footed. (See column 1, lines 32-36 and column 3, lines 18-29). Thus, the roll bar 19 does not assist the golfer in properly bracing during a period of impact, but rather facilitates pivoting of the foot about its outer edge. Thus, as can be seen, the

purpose of the Chiroff invention is opposite to the purpose of the Miller, II invention, as well as being opposite to the purpose of the present invention.

Accordingly it is respectfully submitted that a person having ordinary skill in the art would not have been motivated to modify the Miller, II patent to provide its bladder 22, 42 at only the forward outside portion of the left-handed foot of a right-handed golfer and the right-handed foot of the left-handed golfer, since the teachings of Chiroff are completely opposite the teachings of Miller, II and those of the present invention as to the functioning of the device, and also, as discussed above, since the provision of the bladder 22, 42 and only the forward portion of the shoe would render inoperable the Miller, II invention for its intended purpose. Therefore, for the above and further reasons, it is respectfully submitted that claims 18 and 25 as well as the claims depending therefrom, are clearly allowable over the prior art of record.

The Examiner's attention is next directed to the new independent method claims 32 and 33. Claim 32 recites a method comprising providing a pair of golf shoes for a right-handed golfer, and specifies that the golf shoes are the same as those golf shoes required by the above-discussed independent claim 11 and then claim 32 further specifies the step of performing a golf club downswing from right to left (i.e. the downswing of a right-handed golfer) while wearing said pair of golf shoes and while said inflatable sealed bag is inflated. Similarly, claim 33 recites a method comprising providing the pair of golf shoes for a left-handed golfer, with the pair of golf shoes being those recited in independent claim 25, and then further specifies the step of performing a golf club downswing from left to right (i.e. the downswing of a left-handed golfer) while wearing said pair of golf shoes and while said inflatable sealed bag is inflated.

Therefore, claims 32 and 33 specify, in method form, the same aspects of the present invention as discussed above with regard to the present invention providing a pair of golf shoes for a right-handed golfer wherein an inflatable sealed bag is provided only at the outside portion of the forward portion of the sole of the left foot shoe, and then the golfer performs a golf club downswing from right to left while wearing the golf shoes with the inflatable sealed bag inflated, as would be done by a right-handed golfer. Similarly, in accordance with claim 33, the left-handed golfer wears

the pair of golf shoes with an inflatable sealed bag provided only at the outside portion of the forward portion of the sole of the right foot and performs a golf club downswing from left right while wearing the pair of golf shoes and while the inflatable sealed bag is inflated.

As described above in detail, a person of ordinary skill in the art would not have been motivated to modify the Miller, II golf shoe arrangement which provides a pair of golf shoes for a right-handed golfer in which a bladder 22, 42 is provided along the outside portion of the right foot shoe, or a pair of golf shoes for a left-handed golfer wherein the inflatable bladder 22, 42 is provided along the outside portion of the left foot shoe, in such manner as to result in or otherwise render obvious the invention as recited in method claims 32 and 33, which respectively require a right-handed golfer to perform a downswing while wearing a pair of golf shoes having an inflatable sealed bag at only the front outer portion of the left foot shoe, and a left-handed golfer to perform a downswing while wearing a pair of golf shoes having an inflatable sealed bag at only the front outer portion of the right foot shoe. The O'Brien and Wellman patents also, as discussed above, disclose the provision of removable support devices for golf shoes wherein the support devices are provided under the outside portion of only the right foot shoe for a right handed golfer and only the left foot shoe for a left handed golfer. The Chiroff patent discloses a very different golf training device which has the purpose of precluding the golfer from remaining generally flat-footed and functioning as a roll bar to provide pivoting of the outside portion of the left foot of a right-handed golfer and the right foot of a left-handed golfer, quite contrary to the Miller, II patent and the present invention.

Therefore, it is respectfully submitted that a person of ordinary skill in the art would not have been motivated to modify the Miller, II arrangement or to make any combination of the references of record in such a manner as to result in or otherwise render obvious the present invention as recited in any of the independent claims 11, 18, 25, 32 and 33, or any of the claims depending therefrom. Therefore, it is respectfully submitted that all of the claims 11-33 are clearly allowable over the prior art of record.

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is clearly in condition for allowance. An early notice thereof is earnestly solicited.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, it is respectfully requested that the Examiner contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

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